

DOCKET NO.: ALZA-0377/ALZ5016USNP
Application No.: 10/814,705
Office Action Dated: November 5, 2007

PATENT
REPLY FILED UNDER EXPEDITED
PROCEDURE PURSUANT TO
37 CFR § 1.116

REMARKS

Following entry of the foregoing amendments, claims 17 to 21 will be pending in this patent application. Claim 17 has been amended herein. No claims have been canceled, and no new claims have been added. Support for the amendments is found throughout the specification as originally filed, including, for example, paragraph 25, and the amendments thus do not introduce new matter into the application.

Applicant respectfully requests reconsideration of the rejections of record in view of the foregoing amendments and the following remarks.

Alleged Anticipation

Claims 17 to 21 have been rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. patent number 5,857,994 (“the Flower patent”). In addition, claims 17 to 21 have been independently rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. patent number 5,857,994 (“the Kurabayashi patent”). Applicant respectfully requests reconsideration and withdrawal of the rejections because the Flower and Kurabayashi patents each fail to teach or suggest every limitation of the present claims, and the Office has failed to establish that the missing limitations are inherent in the teachings of either patent.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

The Flower and Kurabayashi patents each fail to teach or suggest every limitation of the pending claims. Specifically, the patents each fail to teach or suggest an electrotransport device that comprises a non-conductive housing for the reservoir of the device that comprises a substantially flexible electrically conductive element integrally molded within the non-conductive housing, *wherein a substantially liquid and moisture-impermeable bond is created between the material forming the reservoir housing and the conductive element*. Neither patent describes an electrically conductive element *integrally molded* within a non-conductive electrotransport device reservoir housing. Moreover, neither patent teaches or suggests that a

substantially liquid and moisture-impermeable bond is formed between the housing and the electrically conductive element. The Flower and Kuribayshi patents thus each fail to teach or suggest every limitation of the present claims.

Although the Office asserts, with respect to the devices described in the Flower patent, that “a substantially liquid and moisture-impermeable bond is created between the material forming the reservoir housing and the conductive element”¹ because “the traversing conductive element is sealed by the housing,”² the Office fails to specifically indicate which portion of the patent describes the alleged seal. Nor does the Office identify where the patent describes a substantially liquid and moisture-impermeable bond between the reservoir housing and the conductive element. Significantly, the Flower patent, in fact, contains no teaching that a liquid and moisture-impermeable seal is formed between a conductive element and housing of an electrotransport device.

Similarly, with respect to the devices described in the Kuribayshi patent, the Office asserts that “a bond is created between the material forming the reservoir housing and the conductive element [that]...is substantially impermeable to liquid and moisture as the traversing conductive element is sealed by the housing.”³ Again, the Office fails to indicate which portion of the patent describes a seal or bond between the reservoir housing and the conductive element, much less specify which portion of the patent indicates that the bond is substantially impermeable to liquid and moisture. As with the Flower patent, the Kuribayshi patent contains no teaching that a liquid and moisture-impermeable seal is formed between the conductive element and the housing.

The Flower and Kuribayshi patents thus fail to explicitly teach or suggest every limitation of the present claims. Significantly, the Office has failed to provide the necessary showing that the claim limitations that are not taught or suggested in the Flower and Kuribayshi patents are inherent in each patent’s teachings. Although the Office asserts, with respect to each of the Flower and Kuribayshi patents, that “the bond [between the reservoir housing and the

¹ Office action dated November 5, 2007, page 3.

² *Id.*

³ *Id.* at page 4.

conductive element] is inherently liquid and moisture-impermeable as the conductive element would inherently lose functionality of conduction upon liquid or moisture leakage between the housing and the conductive element,”⁴ the Office has failed to establish the asserted inherency.

“To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is *necessarily present* in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. *The mere fact that a certain thing may result from a given set of circumstances is not sufficient.*’” *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-1951 (Fed. Cir. 1999) (emphasis added). “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily flows* from the teachings of the applied prior art.” *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

The Office has failed to demonstrate that the devices described in the Flower and Kuribayshi patents *necessarily* contain a bond between the reservoir housing and conductive element and that the bond is *necessarily* substantially liquid and moisture-impermeable. On the contrary, the Office merely *speculates* that such a bond *may* be present in the devices described in the Flower and Kuribayshi patents because the devices would “lose functionality of conduction upon liquid or moisture leakage between the housing and the conductive element.”⁵ The Office has not established, however, that liquid or moisture leakage between the housing and the conductive element does not necessarily occur in the devices described in the Flower and Kuribayshi patents. The Office has impermissibly assumed that the devices are designed to prevent liquid or moisture leakage because such leakage would cause the devices to lost functionality. Many electrical devices, however, such as televisions and clocks, lose functionality if moisture leaks into the devices, but such devices are not necessarily liquid and moisture impermeable unless specifically designed to be so. The Office merely *speculates* that the devices described in the Flower and Kuribayshi patents contain a substantially liquid and moisture-impermeable bond between the reservoir housing and the conductive element, but has

⁴ *Id.* at pages 3 and 4.

⁵ Office Action dated November 5, 2007, page 4.

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failed to demonstrate that such a bond *necessarily* exists in the devices. The Office has therefore failed to establish that the Flower and Kuribayashi patents each inherently describe devices that contain a substantially liquid and moisture-impermeable bond between the material forming the reservoir housing and the conductive element.

Finally, although the Office asserts that the “Examiner can reject the current claim limitations with a large variety of prior art including for instance a coaxial cable connector (that would fall under the scope of a current electrotransport device) or a plastic toy having electronic circuitry and wiring,”⁶ such art would not anticipate or render obvious the presently claimed electrotransport devices. Claim 17 has been amended herein to recite electrotransport devices that comprise a non-conductive housing for the reservoir of an electrotransport device. Applicant notes that a coaxial cable connector and a plastic toy having electronic circuitry and wiring do not comprise a housing for the reservoir of an electrotransport device. Accordingly, art describing such devices would not impact the novelty or inventiveness of the presently claimed subject matter.

Since the Flower and Kuribayashi patents each fail to explicitly or inherently teach or suggest every limitation recited in the present claims, the patents fail to anticipate the claimed subject matter. Applicant accordingly, respectfully requests withdrawal of the rejections.

⁶ *Id.* at page 5.

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Conclusion

Applicant believes that the foregoing constitutes a complete and full response to the official action of record. Accordingly, an early and favorable action is respectfully requested.

Respectfully submitted,

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